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| EXAMINER |
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GEBREMICHAEL, BRUK A

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3715

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| Office Action Summary | Application No. 10/553,257 | Applicant(s) GORDON, RONI | |
| | Examiner BRUK A. GEBREMICHAEL | Art Unit 3715 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 33-64 and 66-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 33-64 and 66-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/02/2009, 01/12/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following office action is a **Final Office Action** in response to communications received on 11/19/2009. Claims 1, 12, 48, and 56 have been amended; claims 15-32 and 65 have been canceled. Therefore, claims 1-14, 33-64 and 66-94 are pending in this application.

Response to Amendment

2. Applicant's amendment to claim 48 is NOT sufficient to overcome the 35 U.S.C 101 rejection set forth in the previous office action regarding claims 48-55 and 93. The body of the claim does not have any statutory element that sufficiently ties the claimed invention to a statutory subject matter. There appears to be no device or apparatus in the body of the claim to implement the method steps. Note that a machine needs to implement the method steps; however, merely reciting a machine in the method claim (without the machine implementing the method steps) does not satisfy the statutory requirement.

Applicant's amendment to claim 12 is sufficient to overcome the 35 U.S.C. 112, second paragraph rejection set forth in the previous office action. Accordingly, the Examiner withdraws the rejection.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The drawings do not show the features of claims 56-64, since there appears to be no illustration that corresponds to for

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example the packaging material for packaging a plurality of different types of food products. The figures presented illustrate packaging material for single food products only. Therefore, the above feature(s) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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- Claim(s) 48-55 and 93 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting Benson, 409 U.S. at 70); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

There appears to be no device or apparatus in the body of the claim to implement the method steps. Note that a machine needs to implement the method steps; however, merely reciting a machine in the method claim (without the machine implementing the recited steps) does not satisfy the statutory requirement.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- Claims 56-64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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For example claim 56 recites a packaging material for packaging a plurality of different types of food products in an assembly of food products. However, the current specification appears to be silent regarding a packaging material for packaging a plurality of different types of food products, except for merely stating a plurality of labels or tables for providing information about a plurality of different foods, such as foods in a package or other enclosure (e.g. see page 19, lines 19-24 of specification).

- Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim 1 recites, “A device for apportioning food, the device being configured to provide, in response to user input specifying a predetermined number of calories, a portion of food having the a predetermined number of calories”; however, the specification is silent regarding how the claimed device provides a particular portion of a food product once the user has specified a predetermined number of calories as an input data. For example, let the food product be a meat or a piece of bread that has 100 calories. Let’s assume that the user wants to consume just 30 calories of the above food product. According to the above claim, the user inputs a specified number of calories (in this case 30 calories); and the device will provide portion of the food (portion of the meat or bread) that has 30 calories. However, the specification is completely

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silent regarding any structural and/or functional feature(s) of the device to accomplish the above function.

Similarly, claim 2 recites, "the device is configured to correlate weight of the apportioned food with calories and to **cease apportioning food when a correlated weight substantially corresponds to the predetermined number of calories**".

However, the specification does not describe this functional limitation of the device in such a way as to enable one of ordinary skill in the art to make and/or use the invention.

For instance the specification states, "... According to the present invention, this device (1) can accept the desired total caloric content of the package and, accessing (2) the conversion table or ERP (3) described above, can produce the portion or portions needed to result in the calorie- based portions and/or total caloric content" (Page 17, lines 21-23 of the specification); but, this does not enable one of ordinary skill in the art to make and/or use the invention. For instance the disclosure does not describe how the device stops (ceases) apportioning the food product when a predetermined weight or calorie is reached (see *response to argument* below for detail).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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- Claims 40-42, 44 and 91-92 are rejected under 35 U.S.C. 102(b) as being unpatentable over Rhee 2001/0043968. Rhee discloses the following claimed limitations:

Regarding claim 40, a plurality of packages of food, wherein each package of food has an indication thereon of a uniform caloric content of 50 calories or multiples thereof (FIG 1c and 1d),

Regarding claim 41, each package of food has an indication thereon of nutritional information per uniform caloric content (Para.0021),

Regarding claim 42, at least two of the packages contain different types of foods (Fig 1c is "roll cake" and fig 1d is "length of candy"),

Regarding claims 44, 91 and 92, the indication is in the form of a table; each package of food has an indication thereon of a uniform caloric content of 100 calories or multiples thereof; the indications are provided on the front of the package (see FIG 1c and 1d).

- Claims 48-49 and 51 are rejected under 35 U.S.C. 102(b) as being unpatentable over Missler 6,359,239. Missler discloses the following claimed limitations:

Regarding claim 48, a computer-implemented method receiving input corresponding to a food product; determining caloric content of the food product based on the input (col.5, lines 37-45); deriving, based on the caloric content nutritional content of the food product in accordance with a pre-determined number of calories (col.5, lines 61-67); and presenting the nutritional content to a consumer in accordance with the pre-determined number of calories (col.6, lines 1-8),

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Regarding claim 49, utilizing the pre-determined number of calories across a plurality of other food products for deriving nutritional content corresponding to the plurality of other food products (col.6, lines 9-28),

Regarding claim 51, the number of calories per serving of the food product is not presented to the consumer (col.5, lines 61-64).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Missler 6,359,239 in view of Sly 4,300,645.

Regarding claim 1, Missler discloses the following claimed limitations, a device for apportioning food (FIG 1, label 2), the device being configured to provide a portion of food having a predetermined number of calories (col.2, lines 41-16).

Missler does not explicitly disclose, the device configured to provide, in response to the use input specifying a predetermined number of calories, a portion of a food having the predetermined number of calories.

Missler's device is capable of indicating whether the measured weight or calories of the food on the scale is insufficient or excessive (see col.3, lines 61-67 and col.4, lines 1-4). This suggests the fact that the user is capable of inputting any desired weight or calorie of the food to be apportioned into the device, and then add (or reduce) slices

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of the food on the scale until the desired weight or calorie is obtained. Therefore, allowing the user to specify any weight or calorie amount as an input is implicitly suggested by the prior art.

However, Sly discloses an invention that teaches a device configured to provide, in response to the use input specifying a predetermined weight, a portion of a food having the predetermined weight (col.6, lines 14-22).

Missler further discloses that the microprocessor of the device comprises preprogrammed data for calculating calories associated with the food quantity based upon the preprogrammed data representatives of calories per unit weight (see col.5, lines 61-67 and col.6, lines 1-3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Sly by integrating a cutting device such as a slicer that utilizes a balanced Wheatstone bridge controlling unit in order to allow the device to slice the given food product until the deposited food on the scale reaches the desired weight or calorie so that the controlling unit would automatically stops slicing additional portions when the desired amount is reached; thereby making the modified device more efficient to apportion the food product into any desired weight or calorie without human intervention.

Regarding claim 2, Missler in view of Sly teaches the claimed limitations as discussed above.

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Missler further discloses, a scale for dynamically weighing apportioned food (col.2, lines 56-60), the device is configured to correlate weight of the apportioned food with calories (col.6, lines 14-22).

Sly further teaches a device configured to cease apportioning food when the desired weight of food has been deposited on the scale (col.3, lines 5-19).

Therefore, as already described with respect to claim 1, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Sly by integrating a cutting device such as a slicer that utilizes a balanced Wheatstone bridge controlling unit in order to allow the device to slice the given food product until the deposited food on the scale reaches the desired weight or calorie so that the controlling unit would automatically stops slicing additional portions when the desired amount is reached; thereby making the modified device more efficient to apportion the food product into any desired weight or calorie without human intervention.

Missler in view of Sly teaches the claimed invention as discussed above. Missler further discloses,

Regarding claim 3, correlation is performed based on one or more instructions stored in a tangible medium (col.2, lines 56-60),

Regarding claim 4, the device is configured to access internal or external software including instructions for correlating weight of the apportioned food into calories and causing the device to cease apportioning food when the weight is substantially equivalent to the predetermined number of calories (col.6, lines 3-8),

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Regarding claim 5, the device is configured to correlate the predetermined number of calories into one or more food units of a particular size, each food unit comprising a number of calories equal to a portion of the predetermined number of calories, and to apportion the one or more food units based on a desired number of calories (col.5, lines 37-45 and col.6, lines 14-28),

Regarding claim 6, Missler does not explicitly disclose, the predetermined number of calories is selected from the group consisting of/about 50, 100, 150, 200, 250, 300, 350, 400, 450, 500, 550, 600, 750, and 1000.

However, one of ordinary skill in the art at the time of the invention was made would readily recognize the fact from the teaching of Missler in view of Sly that the user is capable of apportioning the food product into any desired calorie (or weight) amount using the device of the prior art (e.g. see col.3, lines 61-67), and therefore, specifying such a particular calorie amount (or set of calorie amounts) for a specific purpose requires only a routine skill in the art.

Regarding claim 7, Missler in view of Sly teaches the claimed invention as discussed above.

Sly further teaches, the device is one or more of a slicer, shredder, or dicer (col.2, lines 8-11).

Therefore, as already discussed above it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Sly by integrating a cutting device such as a slicer that utilizes a balanced Wheatstone bridge controlling unit in order to allow the device to slice the

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given food product until the deposited food on the scale reaches the desired weight or calorie so that the controlling unit would automatically stops slicing additional portions when the desired weight or calorie is reached; thereby making the modified device more efficient to apportion the food product into any desired weight or calorie.

Missler in view of Sly teaches the claimed limitations as discussed above. Missler further discloses,

Regarding claim 8, the correlation is performed based on one or more instructions stored in a tangible medium (col.6, lines 3-8),

Regarding claim 9, wherein the food is selected from the group consisting of cheese, fruit, vegetables, poultry, meat, fish and bread (col.1, lines 32-45),

Regarding claim 10, the device is configured to access internal or external software including instructions for correlating the predetermined number of calories into one or more food units of a particular size (col.6, lines 3-8), each food unit comprising a number of calories equal to the predetermined number of calories divided by the total number of food units, and for apportioning the one or more food units based on the desired number of calories (col.6, lines 14-28),

Regarding claims 11 and 13, Missler in view of Sly teaches the claimed limitations as discussed above.

Missler in view of Sly does not explicitly teach, one or more instructions are associated with enterprise resource planning (ERP) software.

However, one of ordinary skill in the art would readily recognize the fact from the teaching of the prior art (e.g. Missler col.6, lines 3-8) that the user would use any

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program in the device that converts the weight of a given food item into a calorie since incorporating such function in the device is already old and well known in the art (as already taught by the prior art); and therefore, using a particular program in the device (e.g. enterprise resource planning, ERP) that has the same function as that of the prior art requires only a routine skill in the art.

Regarding claim 12, Missler in view of Sly teaches the claimed limitations as discussed above.

Sly further teaches, the device is a slicer, the one or more food units are slices, and the particular size is characterized by a slice thickness associated with a slice surface area (col.5, lines 21-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention was made to modify the invention of Missler in view of Sly by integrating a slicer in order to allow the user to easily divide up a given food product such as meat into a desired weight efficiently; thereby allowing the user to produce as many slices as required in a small amount of time.

Note that one of ordinary skill in the art (at the time of the invention was made) recognizes that weight of any food slice is defined by associating the volume and density of the slice; and the volume is defined by associating the thickness of the slice with its surface area. Therefore, apportioning the slice based on a particular weight also implies apportioning the slice based on its thickness and surface area.

- Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Missler 6,359,239 in view of Sly 4,300,645 and further in view of Prussia 5,372,030.

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Regarding claim 14, Missler in view of Sly teaches the claimed imitations as discussed above.

Missler in view of Sly does not explicitly teach, the device is a fruit and/or vegetable sorting machine.

However, Prussia teaches, a device being a fruit and/or vegetable sorting machine (col.5, lines 36-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Sly and further in view of Prussia by incorporating a portable firmness testing device in order to help the user to easily identify the fruits that are ripe before measuring their weight so that the user would collect only those that are ripe and edible.

- Claims 43, 56-59, 64 and 88-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhee 2001/0043968.

Regarding claim 43, Rhee discloses the claimed limitations as discussed above.

Rhee does not explicitly disclose, at least two of the packages have different weights.

However, it is a well known to one of ordinary skill in the art at the time of the invention was made to realize the fact that packages of different food products would have similar or different weights based on the quantity of food packed in the packages, and as such the two different types of food products taught by Rhee (e.g. see FIG 1c, *roll cake*, FIG 1d, *length of candy* and also FIGs 2a, 2b) would have different weights based on their quantity; therefore, reciting this well known practice does not distinguish

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the current invention from the prior art, since doing so requires only routine skill in the art.

Regarding claim 56, Rhee discloses the following claimed limitations; a packaging material for packaging a plurality of food products in an assembly of food products (Para.0008), the packaging material displaying the caloric content of each of a the different types of food products as per-a pre-determined number of calories (Para.0014), wherein the pre-determined number of calories is 50 or a multiple thereof (FIG 3f).

Rhee does not explicitly disclose the packaging material for packaging a plurality of different types of food products; the assembly of food products comprise a plurality of packages of food products.

However, one of ordinary skill in the art at the time of the invention was made would readily realize the fact from the teaching of Rhee that at least the package depicted on FIG 3f has at least two sections that contain different types of food products (see FIG A in the response to argument section below regarding the Examiner's interpretation); and therefore, one of ordinary skill in the art would (at the time of the invention was made) implement such a lunch-basket to wrap various kinds of food packages into one container in order organize and securely store the packages so that it would be much easier for the user to carry the lunch-basket (in stead of carrying multiple packages) specially when traveling from one location to another.

Moreover, such practice is old and well known in the art (before the current invention was made) as disclosed by US 2003/0219513 (see Para.0107).

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Regarding claim 57, Rhee discloses the claimed limitations as discussed above.

Rhee does not explicitly disclose, each of the plurality of different types of food products having the same pre-determined number of calories.

However, since the prior art suggests packing different food products in a container (FIG 3f), it requires only a routine skill in the art (at the time of the invention was made) to pack different food items that have the same calorie content in one container, and food items that have different calories in a separate container in order to allow the user for example to safely separate food items that have high calorie from the food item that have low calories so that the user would not consume a product that has undesired calorie amount.

Moreover, the above practice is old and well known in the art (before the current invention was made) as disclosed US 2003/0219513 (Para.0106); and therefore, this also does not distinguish the current invention from the prior art.

Rhee discloses the claimed limitations as discussed above. Rhee further discloses,

Regarding claim 58, the packaging material further displays nutritional content of each of the different types of food product per the predetermined number of calories for each of the different types of food products (FIG 3f, labels 100cal, 250cal),

Regarding claim 59, even if Rhee does not explicitly disclose the predetermined number is 50 or 100, one of ordinary skill in the art at the time of the invention was made readily recognizes the fact that calories on labels of food packages are often expressed as multiples of some integer values (or percentage values). Thus, when the

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general condition of the claimed subject matter (i.e. labeling calorie values of different food items in a container) is as taught by the prior art (e.g. RHEE FIG 3f), accumulating different food items that have a particular calorie value in a one container requires only a routine skill in the art; and therefore, this does not distinguish the current invention from the prior art.

In addition, the above claimed feature is old and well known in the art (before the current invention was made) as disclosed by US 2003/0219513 (Para.0106).

Rhee discloses the claimed limitations as discussed above. Rhee further discloses;

Regarding claim 64, wherein the pre-determined number of calories is selected from the group consisting of 50, 100, 150, 200, 250, 300, 350, 400, 450, 500, 600, 750 and 1000 (Para.0021, lines 1-9),

Regarding claim 88-90, the plurality of packages are within an arrangement of packages; the arrangement comprises a container; the arrangement comprises a display (FIG 3f).

- Claims 33-39, 45-47, 61-63 and 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhee 2001/0043968 in view of Arrendale 2004/0045202.

Regarding claim 33, Rhee discloses the following claimed limitations; a package containing multiple servings of food (Para.0021), and an indication thereon of the approximate number of calories of one of the multiple servings of the food in the package (FIG 1e or FIG 2a).

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Rhee further implicitly discloses that the approximate number of calories of the food in the package (i.e. the sum of the calories on the package) and the approximate number of calories of one of the multiple servings are different, since it is obvious that the total of the calories of the food in the package is different from the calorie of one serving (see FIG 1e or FIG 2a).

Rhee does not explicitly disclose, the package having an indication thereon of the approximate number of calories of the food in the package.

However, Arrendale discloses a package labeling invention that teaches, a package having an indication thereon of the approximate number of calories of the food in the package (FIG 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Rhee in view of Arrendale by attaching a label on the package that indicates the total amount of calorie of the food in the package in order to help the consumer to easily recognize the total calorie amount he/she is getting from the given package without doing any mental calculation; thereby saving the consumer significant amount of time.

Regarding claims 34-35 and 85-87, Rhee in view of Arrendale teaches the claimed limitations as discussed above.

Rhee further discloses, the total number of calories is about 20 or more calories greater than the number of calories content of a one serving; the total number of calories is about 50% or more greater than the number of calories of a one serving (see FIG 1e, *e.g. compare 200 calories of one serving amount with 1600 calories of total*

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amount); the approximate number of calories of any one of the multiple of servings is 50 or 100; the approximate total number of calories of the multiple of servings is a multiple of 50 or 100 (see FIG 1e, *e.g. identify a serving amount of 100 calories, and 1600 calories of total amount is multiple of 100*); the indications are provided on the front of the package (FIG 1e or FIG 2a).

Regarding claims 36-38 and 45-46, Rhee in view of Arrendale teaches the claimed limitations as discussed above.

Arrendale further teaches, the indications are is in the form of a table; the indication(s) are/is printed; the indication(s) are/is on a label (FIG 1, label 40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Rhee in view of Arrendale by incorporating a label that lists the nutritional element of a food in a package in the form of a table in order to help the user understand the contents of the food and the amount of calorie he/she gets from the food so that the user would make appropriate choice based on his/her diet requirements.

Regarding claim 39 and 47, Rhee in view of Arrendale teaches the claimed limitations as discussed above.

Rhee in view of Arrendale does not explicitly teach, the indication(s) are/is in electronic form.

However, one of ordinary skill in the art at the time of the invention was made would readily recognize the fact from the teaching of the prior art (e.g. Arrendale FIG 1) that the computer printed label is at least prepared and displayed by a computer in

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electronic form in order to allow the user to make some corrections or adjustments to the label before it gets printed and posted on the package; and therefore, the above claimed feature is implicitly suggested by the prior art.

Regarding claims 61 and 62, Rhee discloses the claimed limitations as discussed above.

Rhee does not explicitly disclose, each food product comprises plural servings and the pre-determined number of calories is greater than the number of calories per serving; the pre-determined number of calories of each of the food products is 50% or more greater than the number of calories per serving.

However, Arrendale teaches, each food product comprises plural servings and the pre-determined number of calories is greater than the number of calories per serving; the pre-determined number of calories of each of the food products is 50% or more greater than the number of calories per serving (Para.0010).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Rhee in view of Arrendale by incorporating a label on the food packages that lists various serving amounts in order to help the user to easily understand the amount of nutrition that he/she gets from the food product based on the types of servings, so that the user would use a particular serving size consistent with his/her nutritional needs.

Regarding claim 63, Rhee discloses the claimed limitations as discussed above.

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Rhee does not explicitly disclose, the nutritional content of each of the food products being reported comprises the weight, price, fat (saturated and unsaturated), protein, carbohydrate, vitamin and mineral content of the product.

However, Arrendale teaches, the nutritional content includes the weight, the fat, the saturated fat, the protein, the carbohydrate, the vitamin and mineral of the product (FIG 1, label 40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Rhee in view of Arrendale by including food package that displays important nutritional information mandated by USDA in order to inform the consumer the type of nutritional elements that he/she gets from a given package of food; thereby helping the consumer to easily pick a particular package based on his/her diet requirement.

Note that even if Rhee in view of Arrendale does not explicitly teach some of the recited nutritional content (e.g. price), when the general condition of the claimed subject matter is as taught by the prior art (e.g. Arrendale FIG 1) incorporating additional information on the food package in addition to the basic nutritional elements requires only a routine skill in the art; and therefore, this does not distinguish the current invention from the prior art.

- Claims 50, 55 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Missler 6,359,239.

Regarding claim 55, Missler discloses the claimed limitations as discussed above.

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Missler does not explicitly disclose, the predetermined number of calories is selected from the group consisting of 50, 100, 150, 200, 250, 300, 350, 400, 450, 500, 550, 600, 750, and 1000.

However, one of ordinary skill in the art at the time of the invention was made would readily recognize the fact from the teaching of Missler that the user is capable of apportioning the food product into any desired calorie (or weight) amount using the device of the prior art (col.3, lines 61-67) in order to allow the user to acquire a particular amount of the food product based on his/her diet requirement; and therefore, specifying a particular calorie amount (or set of calorie amounts) for a specific purpose requires only a routine skill in the art.

Regarding claim 50 and 93, Missler discloses the claimed limitations as discussed above.

Missler does not explicitly disclose, the pre-determined number of calories is 50 or a multiple thereof; the pre-determined number of calories is 100 or a multiple thereof.

However, as already discussed with respect to claim 55, one of ordinary skill in the art at the time of the invention was made would readily recognize the fact from the teaching of Missler that the user is capable of apportioning the food product into any desired calorie (or weight) amount using the device of the prior art (col.3, lines 61-67) in order to allow the user to acquire a particular amount of the food product based on his/her diet requirement; and therefore, specifying a particular calorie amount (or set of calorie amounts) for a specific purpose requires only a routine skill in the art.

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- Claims 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Missler 6,359,239 in view of Arrendale 2004/0045202.

Regarding claim 52, Missler discloses the claimed limitations as discussed above.

Missler does not explicitly disclose, the pre-determined number of calories is different from the number of calories per suggested serving size of the food product or number of calories per weight unit of the food product.

However, Arrendale teaches, the pre-determined number of calories is different from the number of calories per suggested serving size of the food product or number of calories per weight unit of the food product (FIG 1, label 40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Rhee in view of Arrendale by specifying the total amount of calorie in the food package and the suitable serving amount of the food item on the label in order to update the consumer the total amount of calorie he/she is getting per package and also the recommended amount of calorie so that the consumer would make appropriate choice when purchasing or consuming the product.

Regarding claim 53, Missler in view of Arrendale discloses the claimed limitations as discussed above.

Missler in view of Arrendale does not explicitly disclose, the pre-determined number of calories is 50% or more calories greater than the number of calories per suggested serving size of the food product.

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However, one of ordinary skill in the art at the time of the invention was made would readily recognize the fact that a package of a given food product often has a calorie value (total calorie value of the package) higher than the serving value in order to indicate to the consumer the recommended amount of serving for food product; and therefore specifying this calorie amount to be some specific value (or percentage) requires only a routine skill in the art.

Regarding claim 54, Missler discloses the claimed limitations as discussed above.

Missler does not explicitly disclose, the nutritional content includes the weight content, the price, the fat content, the saturated fat content, the unsaturated fat content, the trans fat content, the protein content, the carbohydrate content, or the vitamin and mineral content, or a combination thereof.

However, Arrendale teaches, the nutritional content includes the weight content, the fat content, the saturated fat content, the protein content, the carbohydrate content, the vitamin and mineral content, or a combination thereof (FIG 1, label 40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Arrendale by including food package that displays important nutritional information mandated by USDA in order to inform the consumer the type of nutritional elements that he/she gets from a given package of food; thereby helping the consumer to easily pick a particular package based on his/her diet requirement.

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Note that even if Missler in view of Arrendale does not explicitly teach some of the recited nutritional content (e.g. price), when the general condition of the claimed subject matter is as taught by the prior art (e.g. Arrendale FIG 1) incorporating additional information on the food package in addition to the basic nutritional elements requires only a routine skill in the art; and therefore, this does not distinguish the current invention from the prior art.

- Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhee 2001/0043968 in view of Bukowski 2003/0106940.

Regarding claim 60, Rhee discloses the claimed limitations as discussed above.

Rhee does not explicitly teach, the number of calories per serving of the food products is not displayed.

However, Bukowski teaches, the number of calories per serving of the food products is not displayed (FIG 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Rhee in view of Bukowski by incorporating a computer readable barcodes in order to label food packages that do not have enough space to hold detailed printed information, so that the user would simply scan the bar code thereby acquiring the required information regarding the food item.

- Claims 66-73, 75-81, 83-84 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Missler 6,359,239 in view of Teraoka 2003/0004750.

Regarding claim 66, Missler discloses the following claimed limitations; an apparatus configured to weigh food and determine a number of calories associated with

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a particular weight and particular type of food (col.5, lines 61-67), provide other nutritional information based on the number of calories and the particular type of food (col.6, lines 1-8).

Missler does not disclose, determine a price for weighed food

However, Teraoka teaches, determine a price for weighed food (see Para.0032, lines 1-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Teraoka by incorporating a pricing device which calculates and prints or displays the price of a given food product based on the weight in order to help the consumer to determine whether the cost of the food is within his/her ability to buy so that the consumer either reduces or increases the weight of the food to match his/her budget; thereby facilitating a smooth transaction at the checkout line.

Regarding claim 67, Missler in view of Teraoka teaches the claimed limitations as discussed above.

Teraoka further teaches, the apparatus is configured to be provided at a point-of-sale terminal (Para.0038 and Para.0070, lines 1-5).

Therefore, as already indicated with respect to claim 66, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Teraoka by incorporating a pricing device which calculates and prints or displays the price of a given food product based on the weight in order to help the consumer to determine whether the cost of the food is within his/her

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ability to buy so that the consumer either reduces or increases the weight of the food to match his/her budget; thereby facilitating a smooth transaction at the checkout line.

Missler in view of Teraoka teaches the claimed limitations as discussed above.

Missler further discloses,

Regarding claim 68, the number of calories and/or the other nutritional information are presented to a user via a display (col.5, lines 61-67),

Regarding claims 69 and 70, the number of calories is determined based on a plurality of predefined associations for the type of food relating a plurality of weights to a plurality of calories; the plurality of associations is stored in a memory of the apparatus or retrieved from an external storage (col.6, lines 9-22),

Regarding claim 71, Teraoka further teaches, the plurality of associations retrieved from an external storage location is associated with an enterprise resource planning (ERP) software (Para.0073, lines 1-6 and Para.0074).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention as made to modify the invention of Missler in view of Teraoka by connecting the pricing device with an administration device that stores manufacturing data related to the food products in order to allow the pricing device to get up-to-date information for the food items such as current prices of the food products, so that the consumer would get all the latest information before purchasing or consuming the product.

Note that even if Missler in view of Teraoka does not explicitly state enterprise resource planning (ERP) software, one of ordinary skill in the art would readily

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recognize from the teaching of the prior art that any suitable software that evaluates weight and nutritional information of food products is capable of performing the above claimed limitation; and therefore, incorporating a particular software is a matter of design choice since the device of the prior art works well for the intended purpose.

Regarding claim 72, Missler in view of Teraoka teaches the claimed limitations as discussed above.

Missler further implicitly discloses, the plurality of associations is stored in a weight-calorie conversion table (col.6, lines 23-39).

Regarding claims 73 and 77, Missler in view of Teraoka teaches the claimed limitations as discussed above.

Teraoka further teaches, the number of calories and/or the other nutritional information is presented to a user via a printing device; the apparatus comprises one or more of a wrapping machine, size reduction machine, label printer, or cash register (Para.0032, lines 1-5).

Therefore, as already indicated above, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Teraoka by incorporating a pricing device which calculates and prints or displays the price of a given food product based on the weight in order to help the consumer to determine whether the cost of the food is within his/her ability to buy so that the consumer either reduces or increases the weight of the food to match his/her budget; thereby facilitating a smooth transaction at the checkout line.

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Missler in view of Teraoka teaches the claimed limitations as discussed above.

Missler further discloses,

Regarding claim 75, the apparatus is configured to aggregate a plurality of determined numbers of calories, including the number of calories associated with a plurality of types of food (col.6, lines 23-39),

Regarding claim 76, the apparatus is integrated with or communicatively coupled to another device (col.4, lines 10-17),

Regarding claim 78, the apparatus is further configured to provide aggregated other nutritional information, including the other nutritional information, associated with the plurality of types of food, and to determine an aggregated price for a plurality of weighed foods, including the weighed food (col.6, lines 23-39).

Regarding claims 79-80 and 84, Missler in view of Teraoka teaches the claimed limitations as discussed above.

Missler in view of Teraoka does not explicitly teach, the determined number of calories is about 50 calories or a multiple thereof; the determined number of calories is about 100 calories or a multiple thereof; the pre-determined number of calories is 100.

However, at the time of the invention was made, one of ordinary skill in the art would readily recognize the fact from the teaching of the prior art that calories on labels of food packages are often expressed as multiples of some integer value (or percentage values) in order to indicate to the consumer recommended amounts of calories according to a normal diet requirements; and therefore, specifying a particular calorie value (or a calorie value which is a multiple a particular integer) on the food package

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requires only a routine skill in the art; and therefore this does not distinguish the current invention from the prior art.

Missler in view of Teraoka teaches the claimed limitations as discussed above.

Missler further discloses;

Regarding claim 81, the apparatus provides the other nutritional information in relation to a pre-determined number of calories of the particular type of food (see col.6, lines 14-39),

Regarding claim 83, a unit weight for the pre-determined number of calories is provided (col.6, lines 23-39).

- Claim 74 is rejected under 35 U.S.C. 103(a) as being unpatentable over Missler 6,359,239 in view of Teraoka 2003/0004750 and further in view of Arrendale 2004/0045202.

Regarding claim 74, Missler in view of Teraoka teaches the claimed limitations as discussed above.

Missler in view of Teraoka does not explicitly teach, the other nutritional information includes fat content, saturated fat content, trans fat content, protein content, carbohydrate content, vitamin content, and/or mineral content.

However, Arrendale teaches, the nutritional content includes the weight, the fat content, the saturated fat content, the protein content, the carbohydrate content, the vitamin content, and/or mineral content of the product (FIG 1, label 40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Teraoka and

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further in view of Arrendale by including food package that displays important nutritional information mandated by USDA in order to inform the consumer the type of nutritional elements that he/she gets from a given package of food; thereby helping the consumer to easily pick a particular package based on his/her diet requirement.

Note that even if Rhee in view of Arrendale does not explicitly teach some of the recited nutritional content (e.g. trans fat content), when the general condition of the claimed subject matter is as taught by the prior art (e.g. Arrendale FIG 1) incorporating additional information on the food package in addition to the basic nutritional elements requires only a routine skill in the art; and therefore, this does not distinguish the current invention from the prior art.

- Claim 82 is rejected under 35 U.S.C. 103(a) as being unpatentable over Missler 6,359,239 in view of Teraoka 2003/0004750 and further in view of Overman 5,483,472.

Regarding claim 82, Missler in view of Teraoka teaches the claimed limitations as discussed above.

Missler in view of Teraoka does not explicitly teach, the price is determined in relation to the pre-determined number of calories and a unit price for the pre-determined number of calories is provided.

However, Overman teaches, a device which the price is determined in relation to the pre-determined number of calories and a unit price for the pre-determined number of calories is provided (col.4, lines 1-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Teraoka and

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further in view of Overman by incorporating a portable record keeper in order to help the user to determine the price of the food items he/she is purchasing in addition to the calorie so that the user would make a proper choice of the food he/she is purchasing based on not only the calorie of the food item, but also the price of the food item.

- Claim 94 is rejected under 35 U.S.C. 103(a) as being unpatentable over Missler 6,359,239 in view of Overman 5,483,472.

Regarding claim 94, Missler discloses the following claimed limitations; an apparatus comprising a scale configured to weigh food (FIG 1, label 16), and a processor configured to dynamically determine caloric content and at least one other piece of nutritional information for a particular quantity of food being weighed by the scale (col.6, lines 14-39), wherein the nutritional information is output to a display for presentation in accordance with a pre-determined number of calories (see e.g. col.5, lines 37-45).

Missler does not disclose, nutritional information along with a price for the particular quantity of food output to a display.

However, Overman teaches a device on which nutritional information along with a price for the particular quantity of food output to a display (col.4, lines 1-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Overman by incorporating a portable record keeper in order to help the user to determine the price of the food items he/she is purchasing in addition to the calorie so that the user would

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make a proper choice of the food he/she is purchasing based on not only the calorie of the food item, but also the price of the food item.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 33, 40-42, 56-59 and 64 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 35-37 and 45-47 of the pending Application No. 11/147253; and also over claims 23, 37, 51, 58-59, 63-64, 97, 106-107, 110, 116-117, and 121-122 of the pending application No. 10/151106.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed features appear to be an obvious modification of the claims in the corresponding pending application. For example, claim 56 of the current application recites "a packaging material for packaging a plurality of different types of food products in an assembly of food products". This appears to a routine modification of the device recited in claim 1 of the pending application 11/147253. Thus, it would have been obvious to one of ordinary skill in the art at the time of the current invention was made to recognize the device recited in claim 1 (of the pending application 11/147253) as the package for packaging the food products, since the functional limitation of this device is similar to the packaging material recited in claim 56 of the current application, 10/553257.

Similarly, in the case of pending application 10/151106, for example claim 56 of the current application recites similar limitations as claim 23 of the pending application 10/151106, except for the type of food packaged in the package. However, it would

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have been an obvious modification to one of ordinary skill in the art at the time of the invention was made to incorporate any additional information such as the type of food on the package (in addition to the calorie content) to identify the product.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments.

9. Applicant's arguments filed on 11/19/2009 have been fully considered but they are not persuasive. In the remarks, Applicant argues that,

(1) In the statement of the objection, the Examiner asserted that there is no illustration of the packaging material for packaging a plurality of different types of food products. Applicant disagrees.

In the first paragraph of page 9 of the written description of the specification it is disclosed that the packaging material that packages the food product displays the nutritional content of a food product per a pre-determined approximate number of calories or Centicals. Clearly, such displays, which the packaging material comprises, are shown, for example, in Figs. 6, 7, 8, 9, and 10, wherein nutritional content per number of calories or Centicals is depicted. The packaging material encloses the food product and comprises the labels depicted, for example, in Figs. 6, 7, 8, 9, and 10. Clearly, and as one having ordinary skill in the art would easily recognize, these drawings do, indeed, illustrate the claimed packaging material . . .

. . . Based on the foregoing, it is apparent, and one having ordinary skill in the art would easily recognize, that the claimed packaging material is adequately illustrated in

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the drawings. Applicant, therefore, submits that the imposed objection of claims 56 through 64, for lack of illustration in the drawings is not factually viable and, hence, solicits withdrawal thereof.

- In response to argument (1), the examiner disagrees. First of all, the objection is directed to the drawings, but not to the specification. The specification may discuss various issues regarding the invention, but that does not mean that every issue discussed in the specification is illustrated in the drawings. Figures 6-10 illustrate different labels, but not “a packaging material for packaging a plurality of food products in an assembly of food products”, as recited in claims 56-64. Note that what is recited in the above claims is “**a packaging material for packaging a plurality of different types of food products . . .**” Thus, the drawings must show a packaging material (a single packaging material) that is capable of packaging different types of food products; but not merely plurality of labels as depicted in figures 6-10 (as Applicant attempted to argue). One may place such labels on any suitable displaying surface capable of holding the label(s), but that does not mean that the displaying surface to which the labels are attached is “a packaging material for packaging a plurality of different types of food products in an assembly of food products”.

In addition, Applicant's argument appears to contradict with the disclosure regarding the above claimed feature. In an attempt to overcome the objection, Applicant indicated that the first paragraph of page 9 of the specification describes the above claimed feature.

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Of course, the Examiner disagrees with the above assumption since no such feature is even mentioned in the disclosure. What is discussed in the above paragraph (first paragraph of page 9 of Applicant's specification) is a packaging material for packaging a food product, BUT NOT a packaging material for packaging **a plurality of different types of food products**, let alone in an assembly of food products. There is a significant difference between *a packaging material that is capable of packaging one food product*, and *a packaging material that is capable of packaging a **plurality of different types of food products***.

Therefore, the objection of the drawings still holds.

(2) The claim analyzed by the court in *Bilski* was directed to a "method for managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price comprising" various steps. It is noteworthy that the *Bilski* claim, unlike claims 48 through 55 and 93 in the instant case, was not restricted to any apparatus or machine for implementing the recited method ...

Based on the foregoing, it is apparent that the subject matter of claims 48 through 55 and 93, being directed to a "computer-implemented" method, and thus tied to a specific machine, and also transforming a food product input into a presentation of nutritional content in accordance with a pre-determined number of calories, clearly falls within the ambit of 35 U.S.C. § 101.

- In response to argument (2), the Examiner respectfully disagrees. Whether the claim that was considered by the court in *Bilski* was a "*method for managing the consumption risk costs of a commodity sold by a commodity provider*" or some other

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method claim, the law established by the court applies for ANY method claim regardless of its intended use. Note that what is needed here is whether the identified claims in the above rejection (i.e. claims 48-55 and 93) satisfy the statutory requirement under 35 U.S.C 101, but not analyzing the actual claim that was considered by the court, since the law applies equally for ALL types of method claims. Therefore, the above argument appears to be irrelevant to the current issue.

For example claim 48 recites, *“A computer-implemented method comprising: receiving input corresponding to a food product; determining caloric content of the food product based on the input; deriving, based on the caloric content, nutritional content of the food product in accordance with a pre-determined number of calories; and presenting the nutritional content to a consumer in accordance with the pre-determined number of calories”*.

Here, the preamble of the claim recites a computer-implemented method; however, the body of the claim does not recite any statutory element (such as an apparatus or device) utilized to implement the recited method steps. Therefore, the claims do not have sufficient tie to any statutory element. Note that merely reciting a device or an apparatus in the preamble of the claim does not mean that there is a sufficient tie to that particular device or apparatus, unless such sufficient tie is positively indicated in the body of the claim.

In addition, the claims do not transform any underlying subject matter to a different state or thing, as required under 35 U.S.C 101. In fact no such **article** or **material** transformation is indicated in the recited method steps (e.g. see currently

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presented claim 58). The claim merely recites the steps of organizing information to be displayed on the package.

Therefore, the 35 U.S.C. 101 rejection still applies.

(3) The Examiner asserted that the claimed "packaging material" is not disclosed in the specification. This rejection is traversed.

As previously argued in traversing the drawing objection, there is a clear disclosure, in the first paragraph on page 9, of the written description of the specification, for example, of the claimed "packaging material." The cited portion of the specification recites "...packaging material that packages the food product. The packaging material displays the nutritional content of a food product per a pre-determined approximate number of calories or Centicals..." . . .

Based on the foregoing, it is apparent that the subject matter of claims 56 through 64 is clearly supported by the original disclosure within the meaning of 35 U.S.C. § 112, first paragraph. Applicant, therefore, submits that the imposed rejection of claims 56 through 64 as being based on an inadequate written description is not factually viable and, hence, solicits withdrawal thereof.

- In response to argument (3), the Examiner respectfully disagrees. As already discussed (see *response to argument (1)* above), what is discussed in the above paragraph (first paragraph on page 9 of Applicant's specification) is a packaging material for packaging a food product, BUT NOT a packaging material for packaging **a plurality of different types of food products**, let alone in an assembly of food products. There is a significant difference between *a packaging martial that is capable*

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*of packaging one food product, and a packaging material that is capable of packaging a **plurality of different types of food products**.* Therefore, there is no support in the current specification for the subject matter claimed in claims 56-64. Note that each and every feature presented in the current claims **MUST** have sufficient support in the specification.

Applicant further argued, *"the inquiry to be made regarding a rejection under the written description clause of 35 U.S.C. 112, first paragraph, pertains to whether the disclosure (specification, drawings, claims) **as originally filed** reasonably conveys to the journeyman practitioner in the art that the inventor had possession at that time of that which he now claims. In re Wertheim, 541 F.2d 257, 191 USPQ 90, 98 (CCPA 1976)".*

However, claim 56 as **originally filed** recites, *"A food product and **packaging material** that **packages the food product**, the packaging material displaying the nutritional content of a food product per a pre-determined approximate number of calories or Centicals".* This is very different from the currently presented claim 56 that recites *"**a packaging material** for packaging **a plurality of different types of food products** in an assembly of food products..."*. Therefore, the currently presented claim 56 recites a new subject matter that is neither discussed in the specification nor presented in the claim as originally filed.

(4) In the statement of the rejection the Examiner asserted that the recitation in claim 2 of "the device is configured to correlate weight of the apportioned food with calories and to cease apportioning food when a correlated weight substantially corresponds to

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the predetermined number of calories" is not supported by a disclosure that would enable one skilled in the art to make and use the claimed subject matter. This rejection is traversed.

Firstly, lack of enablement under the first paragraph of 35 U.S.C. § 112 is a question of law. *U.S. Steel Corp. V. Philips Petroleum Co.*, 865 F.2d i247, 9 USPQ2D i46i (Fed Cir. i989); *U.S. V. Telectronic Inc.*, 857 F.2d 778, 8 USPQ2d i217 (Fed. Cir. i988). In rejecting a claim under the first paragraph of 35C.S.C. § 112 for lack of adequate enabling support, it is incumbent upon the Examiner to establish a basis in fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art would not be able to practice the claimed invention, armed with the supporting specification, without undue experimentation ...

Specifically the examiner has not overcome the presumption of enablement, as by advancing technological reasoning to doubt the statements in the specification, or by establishing that the claimed is inherently unbelievable or involves implausible scientific principles. In re Cortright, *supra.*, bearing in mind that the present invention does not flirt with the fringes of human ken, or involve a high degree of unpredictability. The Examiner's attempt to overcome the presumption of enablement falls far short of the mark ...

Thus, in accordance with page 17 of the written description of the specification, and Figs. 15 a, b, and c, the total caloric content of a food package is known, and a table or ERP is accessed in order to determine the portion of the food package needed to result in the desired number of calories, and the amount of food corresponding to that

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desired number of calories is provided (e.g., by slicing off the amount of food corresponding to the desired number of calories). A slicer, or other cutting machine, depicted as portioning device 1 in Fig. 15a, may be employed to provide the portion of food corresponding to the number of calories as provided by the table or ERP...

- In response to argument (4), the Examiner respectfully disagrees. Claim 2 recites for example “the device is configured to correlate weight of the apportioned food with calories and to cease apportioning food when a correlated weight substantially corresponds to the predetermined number of calories”. That means, the device would stop apportioning the food product when a predetermined calorie amount (the calorie amount being determined in relation to the weight of the food) of the food product is reached. For example, the specification discusses (e.g. see pages 17-19 of Applicant's specification) that the device incorporates a conversion table for converting weight of the food to calorie, a scale that computes the price, and a display for displaying weight/price information.

However, there is no discussion in the specification regarding how the device ceases apportioning a given food product when a predetermined calorie/weight is reached. For instance, Applicant argues that a slicer or other cutting machine is the portioning device. Here, a user may use the slicer (or other cutting machine) to cut the particular food until he/she reaches the desired amount of calorie/weight as illustrated in FIG 15a-15c. That means, the user slices the food product and measures it on the scale to verify whether the desired amount of calorie/weight is reached. The device uses the conversion table (internal software, ERP) to convert an inputted calorie amount to

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weight. Note that according to the above example, it is the user that ceases apportioning the food product (i.e. stop slicing the food product) when the particular calorie/weight is reached, but not the device.

Therefore, the specification appears to be silent regarding a controlling mechanism that stops for instance the slicer from cutting additional slices when the required amount of calorie/weight of the food product is reached, as currently recited. Note that according to claim 2, the device is configured to cease apportioning the food when a correlated weight substantially corresponds to the predetermined number of calories.

Therefore, one having ordinary skill in the art would not know how the claimed device would stop apportioning the given food product when a predetermined calorie/weight of the food product is reached.

(5) Claim 1 recites "[a] device for apportioning food, the device being configured to provide, in response to user input specifying a predetermined number of calories, a portion of food having the predetermined number of calories." Thus, the device must "apportion" food or be capable of apportioning food and the device must be capable of providing a portion of food having a predetermined number of calories, the providing being responsive to a user input specifying that predetermined number of calories.

In contrast, Missler et al. disclose a combination cutting board and weighing scale. A user cuts off a portion of food on the cutting board and that portion of food is then slid over to the weighing scale to indicate a weight for that sliced off portion of food. Missler et al. also provide for a caloric content of the sliced off portion of food to be

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displayed. However, the device of Missler et al. does not "apportion" anything, and it clearly does not apportion food having a predetermined number of calories ...

However, in the interest of compact prosecution and to dispel any doubt as to where the predetermined number of calories originates, claim 1 has been clarified to recite that the user provides the predetermined number of calories (i.e., the features of claim 65 have now been incorporated into claim 1 and claim 65 has been canceled). Accordingly, Missler et al. do not anticipate the subject matter of instant claims 1 and 9.

Independent claim 48 recites, inter alia, "deriving, based on the caloric content, nutritional content of the food product in accordance with a pre-determined number of calories; and presenting the nutritional content to a consumer in accordance with the determined number of calories." As previously argued, there is no disclosure in Missler et al. regarding a pre-determined number of calories. Moreover, there is no disclosure in Missler et al. regarding either a derivation of or a presentation of nutritional content of the food product, let alone in accordance with a pre-determined number of calories...

... The above argued differences between the claimed invention and Missler et al. undermine the factual determination that the disclosure of Missler et al. anticipates any of the rejected claims. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claims 1, 9, 48, 49, and 51 as being anticipated by Missler et al. under 35 U.S.C. § 102 (b) is not legally viable and, hence, solicits withdrawal thereof.

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- In response to argument (5), even though Missler anticipates the features of claim 1 (and its identified dependent claim(s)) as previously presented, the above argument is directed to the currently amended claimed features of claim 1. However, a new ground of rejection has been established in this FINAL office action that addresses the currently presented claimed features of claim 1; and therefore, Applicant's argument is now moot.

Regarding claim 48, as currently presented, Missler discloses each and every claimed features of the claim. The interpretation of each recited feature is discussed below. Claim 48 recites:

A computer-implemented method comprising receiving input corresponding to a food product; here, there is no specific requirement **what the input should be**. That means, the user may input weight, ounce, gram or any other parameter related to the food product. Thus, the line "In the preferred embodiment, the cutting board 2 also includes a control panel 38 having one or more selector switches 40, as depicted in FIG. 11 that **allow the user to input information** such as, e.g., **specifying certain parameters** to be measured or displayed. In one embodiment, the cutting board includes a unit selector switch 40a that allows the user to manually select the **units of measurement**, for example, **grams** or **ounces**, to be displayed on the readout 36 when the food is weighed on the scale 20." (col.5, lines 37-45) clearly indicates that Missler's device does receive an input corresponding to the food product such as weight measurement.

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determining caloric content of the food product based on the input; deriving, based on the caloric content, nutritional content of the food product in accordance with a pre-determined number of calories; here also, what is required from the device is to determine caloric content of the food product based on the input. Note also that based on the broadest interpretation of the claims, presentation of information such as calorie contents and servings per weight is nutritional content of the food product. Thus, the line, "... the **microprocessor 100** can **determine** the **calories associated with that food quantity** based upon preprogrammed data representative of **calories per unit of weight** (e.g., grams or ounces) for particular foods or **user input data representative of calories per unit of weight for that food**. The **microprocessor 100** also can be programmed to **calculate a total number of servings for the particular food quantity disposed on the scale** based upon the number of servings per unit of weight..." (col.5, lines 65-67 and col.6, lines 1-7) clearly discloses the above claimed feature. According to the above disclosure, the microprocessor utilizes a preprogrammed data to derive calorie associated with the food quantity on the scale based on calories per unit weight. Furthermore, the microprocessor calculates total number of servings for the food quantity based upon the number of servings per unit weight; and this indicates the fact that Missler's device derives *nutritional content of the food product in accordance with a pre-determined number of calories*. Here, the number of serving for the particular food quantity based upon the number of servings per unit of weight is the *nutritional content of the food product in accordance with a pre-determined number of calories*.

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presenting the nutritional content to a consumer in accordance with the pre-determined number of calories; this feature is also disclosed by the reference. For instance the line, "The microprocessor 100 also can be programmed to calculate a total number of servings for the particular food quantity disposed on the scale based upon the number of servings per unit of weight, and **the serving information** can then be **displayed on the display 32**, if selected by the user as the display option" (see col.6, lines 3-8), discloses the above claimed feature. Here, the display of Missler's device presents the serving information (i.e. presents nutritional content according to the pre-determined number of calories) of the food product so that the user would make a well informed decision before consuming the food product.

Therefore, the Examiner concludes that Applicant's currently presented claimed features have already been disclosed by the prior art for the reasons discussed above.

(6) Specifically, Independent claim 40 recites "A plurality of packages of food, wherein each package of food has an indication thereon of a uniform caloric content of 50 calories or multiples thereof. Rhee fails to disclose a "plurality of packages" with each package having an indication of a "uniform" caloric content.

The Examiner relied on Figs. 1 c and 1 d of Rhee. These figures of Rhee depict separate embodiments of an invention, with Fig. 1 c depicting a roll cake having divided portion lines and caloric content indicators for each portion, and Fig. 1 d depicting a length of candy having divided portion lines and caloric content indicators for each portion...

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... Moreover, Applicant separately argues the patentability of claims 41, 42, and 44. Claim 41 recites "wherein each package of food has an indication thereon of nutritional information per uniform caloric content." Rhee discloses no such indication of "nutritional information," let alone "nutritional information per uniform caloric content." Paragraph [0021] of Rhee, cited by the Examiner as disclosing this feature, contains no such teaching...

The above argued differences between the claimed invention and Rhee undermine the factual determination that the disclosure of Rhee anticipates any of the rejected claims. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, supra.; *Kloster Speedsteel AB v. Crucible Inc.*, supra. Applicant, therefore, submits that the imposed rejection of claims 40 through 42, 44, 91, and 92 as being anticipated by Rhee under 35 U.S.C. § 102 (b) is not legally viable and, hence, solicits withdrawal thereof.

- In response to argument (6), the Examiner disagrees. It appears that Applicant has misinterpreted the teaching of the reference. First of all, it should be noted that the figures illustrated in the reference as FIG 1c and 1d are one embodiment (but not multiple embodiments as Applicant erroneously argued). The reference describes the various embodiments of the prior art device separately, and FIG 1a to FIG 1f are one of the several embodiments. For instance, the line, "**FIGS. 1a to 1f** are views, showing a variety of food products, such as instant noodles, cupped instant noodles, roll cake, length of candy, chocolate, and biscuits, individually having both preliminarily divided-portion lines and calorie content indicators expressed on the divided portions in

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accordance with the **primary embodiment** of this invention, thereby allowing people to easily and precisely know how many calories they are consuming per portion of the food product. **FIGS. 2a to 2e** are views, showing a variety of packages for food products, individually having dotted, dashed, or otherwise segmented lines indicating specific portion sizes of each packed product in accordance with the **second embodiment** of this invention, thus allowing people to easily and precisely know how many calories they are consuming per portion of the food product. FIGS. 2a and 2d show packages for instant noodles. That is, FIG. 2a shows a package for instant noodles, which is segmented into four equal portions, with a calorie content indicator of "300 cal" being expressed on each of the segmented portions in accordance with the first modification of this second embodiment" (Para.0027 and Para.0029, lines 1-13), clearly discloses that FIG1a-FIG 1f represents one embodiment of RHEE's invention, and FIGs 2a-FIG 2e represents another embodiment of RHEE's invention. It appears that Applicant came to the above erroneous conclusion without considering the description of the reference.

Furthermore, the calorie information by itself is nutritional information. Note that the above claims do not distinctly specify what the nutritional information should be; and therefore, calorie information is broadly interpreted as nutritional information. As it can be seen from the figures of the reference, the information is displayed per uniform caloric content (e.g. see FIG 1c, FIG 2a, and FIG 2b). It should further be noted that claimed features are given broadest reasonable interpretation without importing limitations from the specification. For instance, it has been held that Claims are given their broadest reasonable interpretation in light of the supporting disclosure. In re

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Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir.1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

With regard to claim 42, the Applicant repeated the same flawed argument indicating that indicating that FIG 1c and FIG 1d are distinctly different embodiments. The Examiner directs the attention of Applicant for example to paragraphs 0027 and 0029 to indicate the fact that FIG 1c and FIG 1d are indeed the same embodiment.

Regarding claim 44, the figures in RHEE's reference illustrates calorie information of the food product in a table (e.g. see FIG. 1c, FIG 1d, also one of the alternative embodiments as illustrated in FIG 2a – FIG 2c).

Each of the above embodiments independently (without combination) illustrates a table where the calorie information is indicated, as recited in the above claims. Therefore, the Examiner concludes that the above claimed features have already been disclosed by the prior art.

(7) As previously argued Missler et al. do not disclose or remotely suggest, "[a] device for apportioning food, the device being configured to provide, in response to user input, a portion of food having a predetermined number of calories," as in claim 1, or "deriving, based on the caloric content, nutritional content of the food product in accordance with a pre-determined number of calories; and presenting the nutritional content to a consumer in accordance with the pre-determined number of calories," as in claim 48. There is no apparent basis on which to reasonably conclude that one having

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ordinary skill in the art would have found the claimed subject matter obvious within the meaning of 35 U.S.C. § 103. Accordingly, Missler et al. would not have rendered obvious claims 6, 50, 55, and 93, dependent on claims 1 and 48. ...

... Nothing within Missler et al. suggests a "pre-determined number of calories" at all, so there clearly would have been no suggestion of "wherein the predetermined number of calories is selected from the group consisting of about 50, 100, 150, 200, 250, 300, 350, 400, 450, 500, 550, 600, 750, and 1000," as recited in claim 6, with similar recitations in claims 50, 55, and 93. Moreover, it is only Applicant, and not Missler et al., who suggests inputting a desired number of calories of the food to be apportioned by the claimed device . . .

- In response to argument (7), the Examiner disagrees. Here also, the Applicant appears to misinterpret the obviousness rejection with respect to the above claims. Note that there is no combination of references in the rejection pertinent to the above claims even though the rejection is under 35 U.S.C 103(a). Here, the prior art already discloses that Missler's device allows the user to select any desired amount of calorie or weight related to the food product (col.5, lines 60-67 and col.6, lines 1-8), except for explicitly indicating the amounts being multiples of 50 or any other number. However, the teaching clearly suggests to one of ordinary skill in the art that the user is capable of selecting any desired amount of calorie related to the food product for example in order to meet a particular diet requirement. For instance, an individual who wants to reduce his/her weight selects a less amount of calorie related to the food product, whereas an individual who wants to gain additional weight selects a higher amount of calorie related

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to the food product. Therefore, it is very clear from the teaching of the prior art that Missler's device accepts any specific calorie amount the user selects (e.g. see col.3, lines 61-67 and col.4, lines 1-4), whether the amount is a multiple of 50 or any other number.

Moreover, it has been held that to support the conclusion that the claimed invention is directed to obvious subject matter, **either** the **references** must expressly or impliedly suggest the claimed invention **or** the **examiner** must present a convincing line of **reasoning** as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). **

Therefore, the Examiner maintains that the **suggestion** should not necessarily be described in the **reference(s)**, as long as **it is obvious to one of ordinary skill in the art at the time of the claimed invention was made.**

Therefore, the Examiner **still** concludes that since Missler's device is **capable** of accepting any desired weight/calorie information related to the food product; and therefore, the above claimed features do not patentably distinguish the current invention from the prior art, for the reasons discussed above.

(8) Sly merely discloses the deactivation of a food slicer when a desired weight of a sliced food has been deposited on a platform. Missler et al. merely disclose the conversion of a weight of a particular food into an associated number of calories for that food. Clearly, Sly does not cure the previously argued deficiencies of Missler et al. regarding a user input of a pre-determined number of calories and providing a portion of

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food having that predetermined number of calories. Since neither of the applied references discloses or suggests these features, even if the applied references are combined as proposed by the Examiner, and Applicant does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result, noting that claims 2 through 5, 7, 8, and 10 through 13 depend from claim 1 which contains the argued features. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1944 (Fed. Cir. 1988).

Applicant, therefore, submits that the imposed rejection of claims 2 through 5, 7, 8, and 10 through 13 as being obvious under 35 U.S.C. § 103 based on *Missler et al.* and *Sly* is not factually or legally viable and, hence, solicits withdrawal thereof.

- In response to argument (8), the Examiner disagrees. Again, it appears that Applicant has misunderstood the teachings of the references. For instance the Applicant indicated “*Missler et al. merely disclose the **conversion of a weight** of a particular food into an **associated number of calories** for that food*”. However, as **one of ordinary skill in the art** would understand from the teaching of *Missler*, conversion of a weight of a food into a number of calories is not the only subject matter described in the reference that the prior art device is capable of performing. For instance, the reference describes the device being a cutting board having a cutting surface to cut food (see Abstract); and this is clearly different from converting a particular weight into a number of calories. For example, the functional limitation of a given device may be to convert the weight of a given food product into a number of calories, but this does not necessarily mean that the device should be able to cut the food product in order to

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carryout the function of converting weight into a number of calories. This is because these two functional limitations (i.e. cutting a food product and converting the weight of a food product into a number of calories) are two different subject matters, and one can be carried out without necessarily performing the other.

Therefore, from the above brief analysis, one can clearly see that Missler discloses not only the **conversion of a weight** of a particular food into an **associated number of calories** for that food, but also additional structural/functional limitations such as cutting (slicing) the food product (unlike what the Applicant indicated in the above argument in an attempt to disqualify Missler's reference).

Of course, the Applicant further argued that the combined teaching of Missler and Sly would not result the current claimed invention. Here also the Examiner disagrees. First of all, one should note that (see e.g. *response to argument (5)* above), the current disclosure does not have sufficient support regarding the claimed feature, "...the device is configured to correlate weight of the apportioned food with calories and **to cease apportioning food when a correlated weight substantially corresponds to the predetermined number of calories**", as recited in the current claim 2.

Nevertheless, the combined teachings of Missler and Sly does teach or suggest the above claimed feature.

Secondly, as one can clearly see from the *prima facie* case of obviousness presented (see *Claim Rejections - 35 USC § 103* above), one of ordinary skill in the art, at the time of the invention was made, would be readily motivated to modify Missler's device in view of the teachings of Sly in order to increase the efficiency of the device by

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automating the device to stop slicing the food product when the required weight/calorie of the food product is reached. Note that without the modification, Missler's device is a manual device that requires the user's intervention for cutting the food product. Thus, the device does not perform for example the function of cutting unless the user performed the function using the device.

However, the modified system (Missler in view of Sly) does cut the food product and stop further cutting when a particular weight/calorie is reached, making it a more efficient device than the unmodified device.

Therefore, the Examiner concludes that one of ordinary skill in the art, at the time of the claimed invention was made, would be readily motivated to modify the invention of Missler in view of Sly to achieve the above advantages.

(9) Regarding claim 14, the rejection is traversed. Specifically, the Examiner asserted that Prussia discloses a fruit and vegetable sorting machine. But that disclosure does not cure the previously argued deficiencies of Missler et al., viz., a user input of a pre-determined number of calories and providing a portion of food having that predetermined number of calories.

Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicant again does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, supra. Applicant, therefore, submits that the imposed rejection of claim 14 as being obvious under 35 U.S.C. § 103 based on Missler et al. and Prussia is not factually or legally viable and, hence, solicits withdrawal thereof.

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- In response to argument (9), the Examiner disagrees. First of all, regarding the teaching of Missler, a detail explanation has already been provided (see the *Claim Rejections - 35 USC § 103*, and the *response to arguments* sections above), and therefore, this will not be repeated here.

Applicant further argued, “even if the applied references are combined as proposed by the Examiner, and Applicant again does not agree that the requisite basis to support the asserted motivation has been established”. Here, Applicant has not specifically indicated the reason why the combination of the reference would not result the current invention. In addition, Applicant appears to miss the motivation for combining the above two references. For instance, as indicated in the previous office action (and also in this FINAL Office Action), one of ordinary skill in the art, at the time of the invention was made, would be motivated to modify the device of Missler in view Prussia by incorporating a portable firmness testing device in order to help the user to easily identify the fruits that are ripe before measuring their weight so that the user would collect only those that are ripe and edible.

That means, once Missler’s device is modified based on the teachings of Prussia, the modified system would not only enable the user to slice food products and process their weight/calorie information, but also enable the user to determine whether a given fruit is ripe or not before processing the weight and/or calorie information of the fruit. This significantly broadens the applicability of the modified system to different types of food products. Moreover, it also increases the efficiency of the system since the

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user for example does not have waste time and resources by slicing (or cutting) unripe fruits and process the calorie and/or weight information, when the fruits are not edible.

Therefore, the Examiner concludes that one of ordinary skill in the art at the time of the invention was made would be motivated to combine the above references in order to achieve the advantages discussed above.

(10) In rejecting claim 43, the Examiner asserted that it would have been obvious that two different packages of food may have different weights, specifically referring to the roll cake and length of candy in Figs 1 c and 1 d, respectively, in Rhee. However, the Examiner apparently ignored the specific claim language requiring a "plurality of packages." As previously argued in traversing the rejection of claim 40, from which claim 43 depends, Rhee does not disclose or suggest a single embodiment of a plurality of packages wherein each package of the plurality of packages wherein each package has an indication of a uniform number of calories . . .

. . . The Examiner asserted that in Fig. 3f, Rhee discloses the subject matter of claims 88 through 90. That determination is not accurate. Rhee's Fig. 3f merely illustrates a "lunch- basket" wrapped with a wrapper displaying the number of calories of portions of foods. It comprises a single package. That is not an "arrangement of packages," as claimed.

Based on the foregoing Applicant submits that the imposed rejection of claims 43, 56 through 59, 64, and 88 through 90 as being obvious under 35 U.S.C. § 103 based on Rhee is not factually or legally viable and, hence, solicits withdrawal thereof.

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- In response to argument (10), the Examiner respectfully disagrees. Applicant again appears to misinterpret the teaching of the reference. Note that one cannot simply assume, contrary to the reference, that a particular figure (or set of figures) belongs to different embodiments, especially when the reference EXPLICITLY indicates the figures that belong to the same embodiment.

For instance, even though Applicant repeatedly argues that FIG 1c and FIG 1d are not single embodiments, the reference clearly describes that FIG 1c to FIG 1f as being the primary embodiment of RHEE's invention, FIG 2a to FIG 2e as being the second embodiment of RHEE's invention, etc. The Examiner again incorporates part of the discloser that describes the above fact.

For instance the line, "FIGS. **1a to 1f** are views, showing **a variety of food products**, such as instant noodles, cupped instant noodles, roll cake, length of candy, chocolate, and biscuits, individually having both preliminarily divided-portion lines and **calorie content indicators** expressed on the divided portions in accordance with the **primary embodiment** of this invention, thereby allowing people to easily and precisely know how many calories they are consuming per portion of the food product . . . FIGS. **2a to 2e** are views, showing a **variety of packages for food products**, individually having dotted, dashed, or otherwise segmented lines indicating specific portion sizes of each packed product in accordance with the **second embodiment** of this invention, thus allowing people to easily and precisely know how many calories they are consuming per portion of the food product" (Para.0027 and Para.0029, lines 1-7) clearly indicates that FIG 1a to FIG 1f belongs to one embodiment and FIG 2a to FIG 2e

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belongs to a different embodiment, etc. It is unclear to the Examiner how/why Applicant reached such erroneous conclusion specially when the prior art reference clearly indicates the figures that belong to the same embodiment.

In addition, as it is clear from the above paragraphs and the figures, the packages indeed have *uniform calorie content indicators*.

With respect to claim 56, Applicant further argued, “Nowhere in *Rhee* is there any disclosure, suggestion or hint of “an **assembly** of food products ...”. It appears that Applicant is looking for a word-to-word match between what is stated in the claims and the disclosure of the prior art. Note that when examining a given claim(s), the features recited in the claims are considered but not a word-to-word match between what is stated in the claims and the disclosure of the reference.

Thus, regarding the feature recited in claim 56, “... an assembly of food products...” FIG 3f of RHEE’s reference clearly depicts an assembly (i.e. a lunch-basket) that comprises at least three different types of food products (i.e. plurality of food products). Thus, from the teaching of the reference, one of ordinary skill in the art (at the time of the invention was made) would readily recognize the fact that such a lunch-basket would contain any required number of different food packages depending on the interest of the user, in order to satisfy a particular weight/calorie requirement the user wants.

Similarly, with regard to claims 58 and 88, as already described above, calorie information itself is a type of nutritional information. Thus, the calorie information indicated per defined sections of the packages is the nutritional content of the food

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product per the predetermined number of calories for each section. Furthermore, since FIG 3f of RHEE's invention comprises plurality of packages, it is a lunch-basket that comprises an arrangement of different packages.

Of course, as already indicated in the above section (*Claim Rejections - 35 USC § 112*), the futures recited in claim 56 (and the claims that directly or indirectly depends on claim 56) constitute **new matter** since the current specification does not have support for the claimed features.

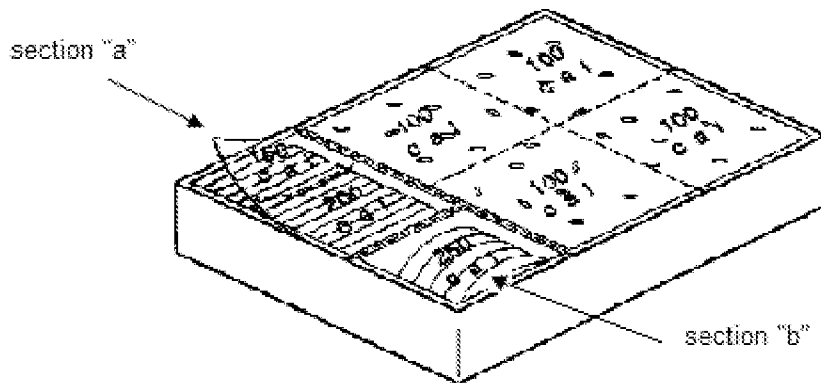


FIG A. (Examiner's interpretation of FIG 3f of Rhee's reference)

(11) This rejection is traversed. Specifically, independent claim 33 recites "the package having an indication thereon of the approximate number of calories of the food in the package; and an indication thereon of the approximate number of calories of one of the multiple servings of the food in the package, wherein the two approximate numbers are different." On page 16 of the Office Action the Examiner acknowledged that "Rhee does not explicitly disclose, the package having an indication thereon of the number of calories of the food in the package (the total number of calories of food in the package)". The Examiner's choice of words - "does not explicitly"- makes it sound that

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somewhere lurking in Rhee's disclosure is a suggestion of this clearly missing feature.

But there is no such suggestion in Rhee ...

...As a fallback position to airbrushing Rhee, the Examiner turned to Arrendale, III et al. and asserted the disclosure of a package having an indication thereon of the approximate number of calories of the food in the package, referring specifically to Fig. 1. That determination is not accurate. But even if it is, which it is not, the mere fact that one reference discloses a package of food with an indication of the total number of calories of food in a package, and another reference provides for an indication of individual servings of food in a package, does not, without more, lead to the conclusion that one having ordinary skill in the art would have been realistically led to provide for both indications on a single package of food ...

... Based on the foregoing Applicant, submits that the imposed rejection of claims 33 through 39, 45 through 47, 61 through 63 and 85 through 87 as being obvious under 35 U.S.C. § 103 based on Rhee and Arrendale, III et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

- In response to argument (11), the Examiner respectfully disagrees. First of all, it should be noted that with respect to claim 33 and the claims that directly or indirectly depends on claims 33; the rejection involves the combined teaching of both RHEE's reference and Arrendale's reference; and therefore, an argument in the form of a piecemeal analysis is not a persuasive argument. Moreover, it has been held that the **test for obviousness** is **not** whether the **features of a secondary reference** may be **bodily incorporated** into the structure of the **primary reference**; **nor** is it that **the**

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claimed invention must be expressly suggested in any one or all of the references. Rather, the test is **what the combined teachings of the references would have suggested to those of ordinary skill in the art.** See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Thus, as it is very clear from the teaching of RHEE's reference (e.g. see FIG 1e), one of ordinary skill in the art (at the time of the invention was made) would readily recognize the fact that the calorie content of the whole package (i.e. the total of the calories of the sectioned parts) is different from the serving size (i.e. the calorie content of a single sectioned part). Thus, the figures depicted in the reference (e.g. RHEE FIG 1e) would have clearly suggested to one of ordinary skill in the art (at the time of the invention was made) that the package has multiple calorie serving sizes that are different from the calorie amount of the whole food package.

In addition to RHEE's teaching, Arrendale's reference also incorporated to further support the fact that such feature is old and well known in the art. For instance, as depicted in FIG 1 of Arrendale's reference, the prior art system indicates a food package label that indicates calorie per serving sizes and per container. Therefore, one of ordinary skill in the art at the time of the invention was made would be motivated to modify the invention of Rhee in view of Arrendale by attaching a label on the package that indicates the total amount of calorie of the food in the package in order to help the consumer to easily recognize the total calorie amount he/she is getting from the given package without doing any mental calculation; thereby saving the consumer significant amount of time.

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Therefore, the Examiner concludes that the combined teaching of the above references does teach or suggest Applicant's currently presented claimed features.

(12) Specifically, claims 52 through 54 depend from independent claim 48. For the reasons advocated above in traversing the rejection of claim 48, there is no disclosure in Missler et al. regarding a pre-determined number of calories or either a derivation of or a presentation of nutritional content of the food product, let alone in accordance with a pre-determined number of calories. Since Arrendale, III et al. do not cure this deficiency of Missler et al., no prima facie case of obviousness has been established with regard to claims 52 through 54.

Applicant, therefore, submits that the imposed rejection of claims 52 through 54 as being obvious under 35 U.S.C. § 103 based on Missler et al. and Arrendale, III et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

- In response to argument (12), the Examiner disagrees. It appears that Applicant simply concluded, "*there is no disclosure in Missler et al. regarding a pre-determined number of calories or either a derivation of or a presentation of nutritional content of the food product, let alone in accordance with a pre-determined number of calories*", without distinctly specifying for example why the identified column sections of Missler's disclosure in the Office Action fails to suggest the claimed features of claim 52-54. As already indicated in the previous Office Action (and also in this FINAL office action), Missler's reference already teaches the features with regard to for example deriving, based on the caloric content nutritional content of the food product in accordance with a pre-determined number of calories (see col.5, lines 61-67); and presenting the

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nutritional content to a consumer in accordance with the pre-determined number of calories (col.6, lines 1-8).

The reference further teaches that the microprocessor of Missler's device is programmed to calculate and determine different calorie/weight information regarding the food product (col.6, lines 3-8). Therefore, it is very clear from the teaching of the reference that the device teaches the limitations, "deriving, based on the caloric content nutritional content of the food product in accordance with a pre-determined number of calories; and presenting the nutritional content to a consumer in accordance with the pre-determined number of calories", for the reasons discussed above.

In addition, in order to establish a *prima facie* case of obviousness, Applicant should be aware of the fact that according to MPEP, **706.02(j) [R-6] Contents of a 35 U.S.C. 103 Rejection** 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references.

After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation >as to< why >the claimed invention would have been obvious

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to< one of ordinary skill in the art at the time the invention was made**.

** “To support the conclusion that the claimed invention is directed to obvious subject matter, **either** the **references** must expressly or impliedly suggest the claimed invention **or** the **examiner** must present a convincing line of **reasoning** as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). **

Therefore, the Examiner maintains that the **suggestion** should not necessarily be described in the **reference(s)**, as long as **it is obvious to one of ordinary skill in the art at the time of the claimed invention was made.**

Therefore, Applicant’s assumption that no prima facie case of obviousness is established is irrelevant. For example, as it can clearly be seen from the rejection established with respect to claim 52, the Office Action states the *teaching of the primary reference, the features missing from the teaching of the primary reference, the teaching of the secondary reference*; and finally *the motivation that would have been obvious to one of ordinary skill in the art (at the time of the invention was made) to modify the primary reference based on the teaching of the secondary reference*. These steps are in accordance with the above established rule of *prima facie* case of obviousness; and the same procedure is followed with all claims.

Therefore, the Examiner maintains that Applicant’s general assumption that “no prima facie case of obviousness has been established” is inaccurate especially without indicating any fact why there is no prima facie case of obviousness.

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(13) Specifically, claim 60 recites "wherein the number of calories per serving of the food products is not displayed." The food package in Rhee does display a number of calories. Fig. 6 of Bukowski shows a package of food wherein no display of a number of calories is apparent. However, the package in Bukowski is depicted for an entirely different purpose, viz, for a bar code, so it is unclear that such a package would not also normally indicate a number of calories per serving of food . . .

Furthermore, claim 60 depends from claim 56. For the reasons argued above, Rhee does not disclose the "assembly of food products" of claim 56. The secondary reference to Bukowski does not cure this deficiency. Applicant, therefore, submits that the imposed rejection of claim 60 as being obvious under 35 U.S.C. § 103 based on Rhee and Bukowski is not factually or legally viable and, hence, solicits withdrawal thereof.

- In response to argument (13), the Examiner disagrees. Whether the intended purpose of the device described in the secondary reference is the same as the intended purpose of the device described in the primary reference is irrelevant. In addition, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.1992).

Thus, in the instant case, Applicant is concerned with a packaging material wherein the number of calories per serving of the food products is not displayed.

Bukowski also teaches such a packaging material that does not display any calorie information (e.g. see FIG 6), as required by the claim. Of course, the question is

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why one of ordinary skill in the art would be motivated to modify the device of RHEE in view of the teachings of Bukowski.

However, as clearly described in the previous Office Action (and also in this FINAL office action), one of ordinary skill in the art (at the time of the invention was made) would be readily motivated to modify the device of RHEE in view of the teachings of Bukowski to eliminate the difficulty to print food product information on smaller packages, since such technique of embedding necessary information about a given food product into a barcode solves the space problem associated with smaller packages (that may otherwise require very fine prints that are illegible to consumers).

Contrary to Applicant's assumption, such modification would not destroy RHEE's invention; rather, the modification would be more advantageous to RHEE's invention since this time the modified device would be applicable to a variety of food packages regardless of the sizes of the packages. That means, the modified device would use normal printing technique for large size food packages, and the barcode technique for small size food packages.

Therefore, the Examiner concludes that the combined teaching of the references does teach or suggest Applicant's currently presented claimed features.

(14) Specifically, independent claim 66 recites, inter alia, "provide other nutritional information based on the number of calories and the particular type of food." For the reasons previously argued, Missler et al. do not provide "other nutritional information based on the number of calories", let alone based on both the number of calories and the particular type of food. The secondary reference to Teraoka, cited by the Examiner

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for an alleged teaching of determining a price for weighed food, does not cure this argued deficiency of Missler et al ... even if the applied references are combined as proposed by the Examiner, and again Applicant does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, supra. Applicant, therefore, submits that the imposed rejection of claims 66 through 73, 75 through 81, 83, 84, and 94 as being obvious under 35 U.S.C. § 103 based on Missler et al. and Teraoka is not legally viable and, hence, solicits withdrawal thereof.

- In response to argument (14), the Examiner respectfully disagrees. Missler's device does teach for example the claimed feature "*provide other nutritional information based on the number of calories and the particular type of food*". For instance, the line "The control panel 38 can include selector switches 40 that allow the user to choose between various display options, such as, for example, specifying whether weight or calories is to be displayed, selecting the orientation of the display 32 or **identifying the food** on the cutting board so **the microprocessor 100 can determine the calories associated with that food** quantity based upon **preprogrammed data representative of calories per unit of weight** (e.g., grams or ounces) for particular foods or user input data representative of **calories per unit of weight** for that food. The microprocessor 100 also can be programmed to **calculate a total number of servings** for the particular food quantity disposed on the scale based upon the **number of servings per unit of weight**, and **the serving information can then be displayed** on the display 32, if selected by the user as the display option" clearly teaches the above fact. (col.5, lines

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61-67 and col.6, lines 1-8), clearly indicates at least two different types of information are indicated. The device calculates or determines the calories associated with the food on the scale; and also calculates and displays the serving information of the food on the scale. That means, the device not only determines the calories associated with the food quantity on the scale, but also indicates other nutritional information such as the serving information based on the number of calories.

Therefore, Applicant's assumption that Missler do not provide "other nutritional information based on the number of calories" is not a persuasive argument.

Similarly, regarding the limitation, "a processor configured to dynamically determine caloric content and at least one other piece of nutritional information for a particular quantity of food being weighed by the scale", as already indicated above, the reference discloses that Missler's device incorporates a microprocessor with a preprogrammed data representative of calories per units of weight for particular foods. That means, when a given type of food (e.g. slice of meat) is placed on the scale, the microprocessor uses its preprogrammed data and dynamically determines the calories associated with that food quantity. In addition to this, the microprocessor also dynamically calculates or determines (based on the preprogrammed data) other nutritional piece of information such as total number of servings for the quantity of food.

Therefore, the Examiner concludes that Applicant's claimed features have already been taught or suggested by the prior art for the reasons discussed above.

(15) Specifically, claim 74 depends from claim 66 and recites "wherein the other nutritional information includes fat content, saturated fat content, trans fat content,

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protein content, carbohydrate content, vitamin content, and/or mineral content." Thus, claim 74 further specifies the "other nutritional content" which neither Missler et al. nor Teraoka disclose or suggest. The Examiner relied on Arrendale, III et al. to provide for this missing claim feature ... Applicant, therefore, submits that the imposed rejection of claim 74 as being obvious under 35 U.S.C. § 103 based on Missler et al., Teraoka, and Arrendale, III et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

- In response to argument (15), the Examiner respectfully disagrees. Note that as already discussed in the above sections, for example the combined teachings of Missler and Teraoka already teaches or suggests the limitation with regard to *providing other nutritional information based on the number of calories and the particular type of food*. However, unlike claim 74, claims 66 and 67 for example do not distinctly point out and specify what this "other nutritional information" encompasses. Therefore, Arrendale's reference need not to be incorporated in the rejections of claims 66 and 67.

However, since claim 74 requires the "other nutritional information" to include specific information, Arrendale's reference is incorporated in the rejection of claim 74 (in addition to the combined teachings of Missler and Teraoka) since Arrendale teaches or suggests the recited nutritional information. Thus, as one of ordinary skill in the art (at the time of the invention was made) would readily recognize from the teaching of the reference (e.g. see FIG 1, label 40), Arrendale does teach or suggest the claimed features of currently presented claim 74. Furthermore, as already indicated in the previous office action (and also in this FINAL office action), it would have been obvious

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to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Teraoka and further in view of Arrendale by including food package that displays important nutritional information mandated by USDA in order to inform the consumer the type of nutritional elements that he/she gets from a given package of food; thereby helping the consumer to easily pick a particular package based on his/her diet requirement.

Therefore, the Examiner concludes that Applicant's currently presented claimed features have already been taught or suggested by the prior art.

(16) Specifically, claim 82 depends from claim 81, which depends from claim 66, and recites "wherein the price is determined in relation to the predetermined number of calories and a unit price for the pre-determined number of calories is provided." Neither Missler et al. nor Teraoka disclose or suggest "other nutritional information based on the number of calories and the particular type of food," as recited in claim 82 via claim 66.

The secondary reference to Overman is directed to a portable electronic food shopper. In one embodiment, a calorie count of foods consumed may be listed with total calories summed at the end of the list (col. 4, lines 6-8). However, nowhere in Overman is to be found any disclosure or suggestion of "other nutritional information based on the number of calories and the particular type of food" (as in claim 66) or "wherein the price is determined in relation to the pre-determined number of calories and a unit price for the pre-determined number of calories is provided" (as in claim 82) ... Applicant, therefore, submits that the imposed rejection of claim 82 as being obvious under 35

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U.S.C. § 103 based on Missler et al., Teraoka, and Overman is not factually or legally viable and, hence, solicits withdrawal thereof.

- In response to argument (16), the Examiner respectfully disagrees. The combined teaching of Missler and Teraoka already teaches or suggests the claimed features of claim 82 except for determining the price in relation to the predetermined number of calories and a unit price for the predetermined number of calories provided.

However, as clearly indicated in the previous Office Action (and also in this FINAL Office action) Overman discloses a portable electronic device that displays the price of the food product and calorie counts. Note that just from the teaching Overman's reference, one of ordinary skill in the art (at the time of the invention was made) would readily know that if the device displays the price of the given food product, it is obvious that the value also shows the price of the total number of calories contained in that food product. This is because, if the given food product has some calories, that calorie cannot exist independent of the food product. For example, if the weight "X" of a particular food product called "a" has 130 calories, and if the weight "X" of the food product "a" costs \$10, then it is equivalent to say that 130 calories of food product "a" costs \$10).

Note that Missler already teaches (for example with respect to the above example) associating a particular weight (i.e. "X") of a particular food product (i.e. "a") with its calories amount (i.e. 130 calories). See for example col.5, lines 61-67 through col.6, lines 1-8, and also see col.6, lines 9-36 of Missler's reference. The only element missing from the teachings of Missler (i.e. the combined teachings of Missler in view of

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Teraoka) is determining the price in relation to the number of calories and a unit price for the predetermined number of calories.

However, as already indicated in the previous Office Action (and also in this FINAL Office action), Overman discloses a portable electronic device that displays the price of the food product and calorie counts of foods consumed. For example the line, "The shopping list device can also be used more generally as a record keeper. For example, to use it to accumulate money spent at several stores, initiate a store list, name the stores in place of products, and enter an **amount spent in place of product price**. The total spent is then automatically summed at the end of the list. Similarly, a **calorie count of foods** consumed **could be listed** with **total calories** summed at the **end of the list**. **Calories expended** could be recorded in the **product description** line and totally separately. Also, longer term lists may be retained and printed, such as a personal home storage inventory and used to guide subsequent purchase needs. Also, a record of standard meals consumed could be kept for a given time period (day, week, etc.) by entering reference codes instead of a product name as data on a list line" (col.4, lines 1-15).

Therefore, as already described above, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Missler in view of Teraoka and further in view of Overman by incorporating a portable record keeper in order to help the user to determine the price of the food items he/she is purchasing in addition to the calorie so that the user would make a proper choice of the

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food he/she is purchasing based on not only the calorie of the food item, but also the price of the food item.

Thus, the Examiner concludes that Applicant's currently presented claimed features have already been taught or suggested by the prior art.

(17) Specifically, independent claim 94 recites, in part, "a processor configured to dynamically determine caloric content and at least one other piece of nutritional information for a particular quantity of food being weighed by the scale" and "wherein the nutritional information, along with a price for the particular quantity of food, is output to a display for presentation in accordance with a pre-determined number of calories." Neither Missler et al. nor Overman disclose or suggest these features ...

Since neither of the applied references discloses or suggests the claim features: "dynamically determine caloric content and at least one other piece of nutritional information for a particular quantity of food being weighed by the scale"; or "nutritional information, along with a price for the particular quantity of food, is output to a display for presentation in accordance with a pre-determined number of calories," even if the applied references are combined as proposed by the Examiner, and again Applicant does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, supra. Applicant, therefore, submits that the imposed rejection of claim 94 as being obvious under 35 U.S.C. § 103 based on Missler et al. and Overman is not factually or legally viable and, hence, solicits withdrawal thereof.

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- In response to argument (17), the Examiner respectfully disagrees. As already described above with respect to response to argument (16), the claimed feature, “a *processor configured to dynamically determine caloric content and at least one other piece of nutritional information for a particular quantity of food being weighed by the scale*”, has already been taught by Missler. For instance, the line “The control panel 38 can include selector switches 40 that allow the user to choose between various display options, such as, for example, specifying whether weight or calories is to be displayed, selecting the orientation of the display 32 or **identifying the food** on the cutting board so the microprocessor 100 can determine the calories associated with that food quantity based upon **preprogrammed data representative of calories per unit of weight** (e.g., grams or ounces) for particular foods or user input data representative of **calories per unit of weight** for that food. The microprocessor 100 also can be programmed to **calculate a total number of servings** for the particular food quantity disposed on the scale based upon the **number of servings per unit of weight**, and **the serving information can then be displayed** on the display 32, if selected by the user as the display option” clearly teaches the above fact. (col.5, lines 61-67 and col.6, lines 1-8), clearly indicates at least two different types of information are indicated. The device calculates or determines the calories associated with the food on the scale; and also calculates and displays the serving information of the food on the scale. That means, the device not only determines the calories associated with the food quantity on the scale, but also indicates other nutritional information such as the serving information based on the number of calories.

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Therefore, Applicant's assumption that Missler do not provide "other nutritional information based on the number of calories" is not a persuasive argument.

Furthermore, as already discussed above, Overman teaches or suggests the claimed feature regarding "a device on which nutritional information along with a price for the particular quantity of food output to a display" (see the above section for detail).

Thus, the next analysis would be given these two references, why one of ordinary skill in the art (at the time of the invention was made) would be motivated to modify the device of Missler based on the teachings of Overman.

However, modifying Missler's device in view of Overman would make the modified system more advantageous because, the modified system displays not only calorie and weight information associated with a particular food product, but also the price information in relation to the calorie; thereby making the modified system a more comprehensive system that provides valuable nutritional and price information to the consumer.

Therefore, one of ordinary skill in the art at the time of the invention was made would be motivated to modify the invention of Missler in view of Overman by incorporating a portable record keeper in order to help the user to determine the price of the food items he/she is purchasing in addition to the calorie so that the user would make a proper choice of the food he/she is purchasing based on not only the calorie of the food item, but also the price of the food item.

Therefore, the examiner concludes that Applicant's currently presented claimed features have already been taught or suggested by the prior art.

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(18) The double patenting rejection is traversed as improper on both a procedural ground and on substantive grounds. Procedurally, the Examiner rejected nine claims of the instant application over seven claims of the copending application, but the Examiner did not specifically identify what portions of which copending claims considered to correspond to those of the rejected claims, and relied upon to support the rejection . . .

Based on the foregoing, it is apparent that the subject matter of claim 56 would not have been obvious over the subject matter of claim 1 of copending Application Serial No. 11/147,253 . . .

Quite clearly, copending claim 23 is directed to a single package of food of a food type with an indication on or in that single package of a predetermined calorie content of 100 calories, along with an indication of availability of other food units. Instant claim 56, on the other hand, is clearly directed to a packaging material for packaging a plurality of different types of food products in an assembly of food products. Claim 23 of the copending application is not concerned with any "packaging material" nor with an "assembly" of food products...

Based on the foregoing, it is apparent that the subject matter of claim 56 would not have been obvious over the subject matter of claim 23 of copending Application Serial No. 10/151,106 . . .

- In response to argument (18), the Examiner disagrees. First of all, there is no such improper "procedural ground" as applicant attempted to imply in the above argument. As long as the current application is claiming similar claimed subject

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matter(s) as that of pending application # 11/ 147253 and pending application # 10/151106, the obviousness type double patenting rejection is proper, and still applies.

Secondly, the Examiner has already discussed the obviousness rejection by presenting examples related to each pending Applications, and therefore there is no such “denying Applicant’s right to procedural due process of law”. In fact, just by considering the claims identified in each case, Applicant can provide reasons why the identified claims in the current application are not obvious over the corresponding claims in the pending applications.

Thirdly, the identified claims in the current application do not have only a one-to-one correspondence between the identified claims in the pending applications. For example, regarding pending application # 11/147253, claims 40 and 41 of the current application recite similar subject matter as claims 1, 35, 36 and 37 of the pending application # 11/147253.

Claims 40 and 41 of the **current application** recites, “(40) *A plurality of packages of food, wherein each package of food has an indication thereon of a uniform caloric content of 50 calories or multiples thereof; (41) the plurality of packages of claim 40, wherein each package of food has an indication thereon of nutritional information per uniform caloric content*”.

Whereas, claims 1 and 35-37 of **Pending application** # 11/147253 recite, “(1) *A dietary system comprising a plurality of devices, each device having an indication thereon for indicating the same caloric content for a different type of food as that indicated by one or more of the other deices; (35) the dietary system according to*

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claim 1, comprising an indication denoting 50 calories or a multiple thereof; (36) the dietary system according to claim 35, comprising an indication denoting 100 calories or a multiple thereof; (37) the dietary system according to claim 36, comprising an indication denoting 100 calories”.

One of ordinary skill in the art (at the time of the claimed invention was made) would readily recognize from the claims of the current application (e.g. claim 40 of the current application) that the recited package is a container device for packaging materials (in this case for packaging food materials), and therefore it directly relates to the device recited in claim 1 of the pending application #11/147253. Note that giving a specific name to a known device does not change or affect the functional limitation of the device; and therefore, such naming does not patentably distinguish one invention from another. In addition, claim 40 of the current application further recites, “*each package of food has an indication thereon of a uniform caloric content of 50 calories or multiples thereof*”. Claim 1 of the pending application # 11/147253 recites, “*each device having an indication thereon for indicating the same caloric content*”.

Here also, one of ordinary skill in the art (at the time of the invention was made) would readily recognize that the “indication” recited in each case refers to the same subject matter which is “indicating the amount of calorie”. Here, one does not have to speculate anything regarding the above claimed limitations since the claims in each case directly refer to the same subject matter.

In the same way with respect to claims 35-37 of the pending application # 11/147253, these claims recite calorie content indication denoting *50 calories or multiple*

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thereof; 100 calories or multiple thereof; and 100 calories, respectively. On the other hand, claims 40 and 41 of the current application recite, *caloric content of 50 calories or multiple thereof; uniform caloric content*, respectively. It is very apparent to one of ordinary skill in the art (having an ordinary mathematical skill), at the time of the claimed invention was made to recognize the fact that 100 is a multiple of 50, and also the positive integers that are multiples of 50 are uniformly distributed (50, 100, 150, 200, 250...); and therefore, this also emphasizes the fact that the claimed limitations recited in the identified claims of both applications are directed to similar subject matter.

The only obvious difference between the identified claims of the above applications is that claim 1 of the pending application recites “*a plurality of devices ... for a different type of food*”.

However, even if the current application does not explicitly recite a plurality of devices for a different type of food, one of ordinary skill in the art at the time of the invention was made would readily recognize the fact from claim 40 of the current application that different food packages would be utilized to package different types of food (e.g. one type of package to pack milk; and another type of package to pack bread) in order to safely secure the given food in the package and prevent contamination; since such implementation is old and well known in the art, and requires only a routine skill in the art.

The same analysis is used for the rest of the identified claims in each application.

In the same way, the following is the comparison between claim 33 of the current application, and claim 23 of the pending application # 10/151106. Here, for example,

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claim 33 of the current application recites, *"A package containing multiple servings of food, the package having an indication thereon of the approximate number of calories of the food in the package; and an indication thereon of the approximate number of calories of one of the multiple servings of the food in the package, wherein the two approximate numbers are different"*; and claim 23 of the pending application recites *"A food unit comprising a package; a type of food packaged in said package; an indication in print on or in said package, said indication: stating a predetermined caloric content of 100 calories for entire package; and indicating an availability of other food units of a plurality of different types of foods, each of said plurality of different types of foods having said predetermined caloric content"*.

It is very clear from the above that claim 33 of the current application recites the same subject matter (a food package comprising indication of caloric contents of the package and serving sizes), as claim 23 of the pending application # 10/151106, except for explicitly reciting for instance, the indication being in print on or in the package. However, it is old and well known in the art (at the time of the invention was made) that information on food packages are printed for example on the external surface of the package; and therefore, one of ordinary skill in the art would readily recognize incorporating such printed information on the external cover of the package (since this requires only a routine skill in the art) e.g. in the case of claim 33 of the current application, in order to provide the required information to the consumer, so that the consumer(s) buying the product would make an informed decision.

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Note that the same type of analysis is established for all the identified claims in the double patenting rejection. Thus, one having ordinary skill in the art would readily recognize the basis for the double patenting rejections for all identified claims according to the examples presented above.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this final office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruk A. Gebremichael whose telephone number is (571) 270-3079. The examiner can normally be reached on Monday to Friday (7:30AM-5:00PM) ALT. Friday OFF.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI XUAN can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruk A Gebremichael/
Examiner, Art Unit 3715

/Cameron Saadat/
Primary Examiner, Art Unit 3715